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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/690,512

Filing Date: October 17, 2000

Appellant(s): HANNAH ET AL.

Timothy N. Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 11/27/06 appealing from the Office action mailed on 08/29/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,650,761

Rodriguez et al.

11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the Appellant regards as his invention.

Claims 5, 15 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

As per claims 5, 15 and 25, it is unclear how the watermark can help determine the speed at which the advertisement was played. In other words, important elements necessary for the understanding of the claim language are omitted therefrom. Thus, The claim will be broadly interpreted.

Claims 1-17 and 19-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Rodriguez, US Patent 6,650, 761 B1

As per claims 1-17 and 19-30, Rodriguez discloses, inter alia, a system for watermarking content, such as a downloaded video or a transmitted advertisement, to thereby guarantee integrity of the downloaded content or transmitted advertisement upon receipt and to correctly bill the recipient of the video content for what was actually received as opposed to what was transmitted or downloaded.

Furthermore, watermark technology is used to track and verify proper delivery of content including advertising content. In one application of this technology, recipients of advertising content, such as TV subscribers, computer users (identified users), are provided incentives for viewing advertising in its entirety. For example, a content-receiving device, such as a computer, can include a watermark detector that issues a receipt for each watermarked

advertisement that is heard/viewed in its entirety (providing accrued incentives or accumulated rewards to an identified user of a computer or a set-top-box for listening to played or viewing displayed watermarked advertisements). These receipts may be redeemed, for example, for content tokens (type of currency), for monetary value, etc. In some embodiments, receipts are generic and can all be applied to a desired premium (such as access to content or otherwise), regardless of the advertisements through which they were earned. In other embodiments, the receipts are associated with the particular advertisers (or class of advertisers). Thus, an identified or a specific TV viewer who accumulates 50 receipts (accrued rewards) for hearing/viewing advertising originating from Procter & Gamble may be able to redeem them for a coupon good for \$2.50 off any Procter & Gamble product, or accrued or accumulated receipts from Delta Airlines may be redeemed for Delta frequency flier miles (e.g., at a rate of one mile per minute of advertising heard/viewed). Such incentives are particularly useful in new forms of media that give the consumer enhanced opportunities to fast-forward or otherwise skip advertising (col. 57: 65 to col. 58: 34).

(Col. 44: 17 to col. 45: 22; col. 24: 23-37; col. 54: 26-54; col. 55: 35 to col. 56: 19; col. 57: 9 to col. 58: 34).

(10) Response to Argument

First of all, the Examiner did not issue the prior actions that led to the first Board decision in the Application, nor did the Examiner maintain the prior actions since the Board had reversed that Examiner's actions. Thus, the related arguments, as herein presented, are moot.

Second of all, regarding the rejections of claims of 5, 15 and 25 under 35 USC 112(2), contrary to the Appellant's contention, although the specification may support or disclose how the **monitoring of the watermark helps determine the speed at which the advertisement was played**, however, limitations from the specification are not directly read into the claimed invention See (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). To this end, the linking or the relationship between the watermark and the speed of playing is rather premature. **In other words, it is not clear how a watermark embedded into a content or an ad can help determine the speed at which such content is being played**, as would have concluded an ordinary skilled artisan. There should be enough claim elements recited in a claim so as to enable one skilled in the art to understand such relationship (and the specification can be reviewed for more details if need).

Third of all, the Appellant argues, regarding the 102 Rejection, that neither the applied reference nor the Office Action teaches "**associating an indication that an advertisement was played with an identifier for a particular user**" as featured in claims 1 and 11. First, as can be seen in the Brief, the Appellant has failed to explicitly point out why the Examiner's interpretation of the above claim element is misconstrued or not supported in the prior art based on the knowledge of an ordinary skilled artisan. Second, in response to the above remarks, the Examiner submits that **each advertisement has, by default, a unique ID, filename or identifier that is used to store the advertisement (data) in a system database and to retrieve it therefrom at a later time or to uniquely identify the advertisement in the system (at the time of download to the time of reception by the specific user)**. Further, each (identified)

advertisement is tracked to determine whether or not it was played in its entirety before the specific user is being compensated for viewing the specific or identified advertisement. In other words, the process of “associating an identifier with an advertisement whether or not the advertisement was played” is implicitly taught or supported in the prior art. Moreover, Rodriguez supports compensating a subscriber or a specific user for each advertisement successfully played in its entirety and thus, that advertisement should be identified before the user is compensated.

In short, the advertisement, as discussed above, has at least a filename or an identifier or code (which is a combination of characters based on the type of operating system involved) used to at least store the advertisement (data) into a system database and to retrieve it therefrom at a later time when, for example, the advertisement information is downloaded to the user’s device where it is presented to the user. By default, the advertisement data are recorded in memory or database under a filename or identifier, which is used to retrieve the advertisement (information) therefrom and to uniquely identify the advertisement (data) in the system. Thus, the advertisement has indeed a filename or identifier associated with it, under which the related advertisement data are recorded, whether or not the play/display of the advertisement is monitored or tracked. To this end, the process of “associating an indication that an advertisement was played with an identifier for a particular user” is anticipated by the reference. Moreover, features that are inherent in the art or widely used or understood in the industry need not be disclosed in a reference in order for these features to be anticipated by the current prior art; in other words, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art does not preclude a finding of anticipation (MPEP 2131.01 (III). Here, it appears that the Appellant is applying a different connotation to the term

“identifier” or improperly reading limitations or specific definition from the specification into the claimed invention. Once again, the Examiner wants to remind the Appellant that although the claims are interpreted in light of the specification, however, limitations or specific definitions from the specification are not read into the claims (See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, Appellant argues that claim 21 calls for a watermark detector to detect a watermark including advertisement and control operation of a media player in response to detection of the watermark and such claim elements are not taught or addressed in the Office Action. However, the Examiner completely and respectfully disagrees with the Appellant’s findings. Indeed, Rodriguez discloses that watermark technology is used to track and verify proper delivery of content including advertising content. In one application of this technology, recipients of advertising content, such as TV subscribers, computer users (identified users), are provided incentives for viewing advertising in its entirety (by controlling the media player, used to play the audio advertisement file, such that the entire watermarked advertisement is heard or consumed without the user’s interruption). For example, a content-receiving device, such as a computer, can include a watermark detector that issues a receipt for each watermarked advertisement that is heard/viewed in its entirety (providing accrued incentives or accumulated rewards to an identified user of a computer or a set-top-box for listening to played or viewing displayed watermarked advertisements). Here, the watermark detector, coupled to the identified user’s receiving device, is operable to detect that a watermarked advertisement is entirely played/heard before issuing a compensation receipt for hearing the advertisement in its entirety. It should herein be

understood that in order to play the advertisement in its entirety, the player/media player (such as a piece of software-e.g. Windows Media Player) should be configured to prevent the user's interruption of the advertisement being played once the watermark detector has detected the presence of a watermark embedded or inserted into the played advertisement file before a compensation receipt, related to the identified and entirely heard watermarked advertisement, can be issued.

(Col. 44: 17 to col. 45: 22; col. 24: 23-37; col. 54: 26-54; col. 55: 35 to col. 56: 19; col. 57: 9 to col. 58: 34).

Therefore, the Appellant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Appellant's arguments as herein presented are not plausible and thus, the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JDJ

02/27/07

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